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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 611

[redacted] CORPORATION,

Petitioner,

vs.

[redacted] COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE [redacted] COURT OF APPEALS FOR THE [redacted] CIRCUIT

[redacted] RESPONDENT IN OPPOSITION

[redacted]

[redacted]

INDEX

	Page
Statement of the Case	1-3
Argument	3-20
The Decisions Below are Clearly Correct	3-4
Chapman et al. and Tobin Patents	4
Chapman et al. Patent No. 2,834,304	4-6
Tobin Patent No. 2,873,695	6-7
Prior Patents and Instances of Alleged Prior Public Use Relied Upon by Petitioner	7-10
The "On Sale" Defense with Respect to the Chapman et al. Claims in Suit	10-12
This Case Presents No Question Requiring Review by this Court	12-20
First Question	12-15
Second Question	15-18
Third Question	18-20
Conclusion	20
Certificate of Service	20
Appendix—(Follows brief).	

TABLE OF CASES, AUTHORITIES AND STATUTES

Cases

Barie v. Superior Tanning Co., 182 F. 2d 724, 728 (C.A. 7)	17
Bede et al. v. Baker & English, 274 F. 2d 833 (C.A. 6)	17
Blish, Mize and Silliman Hardware Company et al. v. Time Saver Tools, Inc., et al., 236 F. 2d 913 (1956—C.A. 10)	14
Burke Electric Co. v. Independent Pneumatic Tool Co., 232 F. 145, (C.A. 2)	19

Page

City of Elizabeth v. American Nicholsen Pavement Co., 97 U. S. 126, 24 L. Ed. 1000 19
Cold Metal Process Co. v. Republic Steel Corporation, 233 F. (2d) 828 (C.A. 6—1956) 13
Crane Packing Company v. Spitfire Tool & Machine Co. Inc., 276 F. 2d 271 (C.A. 7) 17
General Motors Corp. v. The Estate Stove Company, 201 F. 2d 645 (C.A. 6) 17
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147 (1950) 95 L. Ed. 162 10
Guiberson Corp. v. Equipment Engineers, 252 F. 2d 431, 432 (C.A. 5) 17
Interstate Rubber Products Corporation et al. v. Radiator Specialty Company et al., 214 F. 2d 546 (C.A. 4—1954) 14
Jaffke v. Dunham, 352 U. S. 280, 281, 1 L. Ed. 2d 314, 315 16
Jameo, Incorporated, v. Carlson, 274 F. (2d) 338 (1959—C.A. 10) 14
John Blue Company, Incorporated v. Dempster Mill Mfg. Co., 275 F. (2d) 668 (C.A. 8—1960) 14
Katz v. Horni Signal Mfg. Corp., 145 F. 2d 961, 962 (C.A. 2) 16
Kwikset Locks v. Hillgren, 210 F. 2d 483 (C.A. 9) .. 17
Langnes v. Green, 282 U. S. 531, 538, 75 L. Ed. 520, 525 16
Lincoln Engineering Co. of Illinois v. Stewart-Warner Corporation, 303 U. S. 545; 82 L. Ed. 1008 (1937) 10
Magnum Import Company v. Coty, 262 U. S. 159, 67 L. Ed. 922 4
Moore v. C. R. Anthony Co., 198 F. 2d 607, 608 (C.A. 10) 17

Page

Morley Construction Co. v. Maryland Casualty Co., 300 U. S. 185, 191, 81 L. Ed. 593, 597 16

McCreery Engineering Co. v. Massachusetts Fan Co., 195 F. 498 (C.A. 1) 19

McBrine, L. Co. Ltd. v. Silverman, 121 F. 2d 181, 182 (C.A. 9) 17

Story Parchment Co. v. Patterson Parchment Paper Co., 282 U. S. 555, 560, 75 L. Ed. 544, 547 16

Tinnerman Products, Inc. v. George K. Garrett Co. Inc., 292 F. 2d 137, 138 (C.A. 3) 16-17

United States v. American Railway Express Company, 265 U. S. 425, 435, 68 L. Ed. 1087, 1093 .. 16

United States v. Carignan, 342 U. S. 36, 38, 96 L. Ed. 48, 51 16

Wende v. Horine, 225 F. 501 (C.A. 7) 19

Zooman, Inc. v. Paillard Products, Inc., 258 F. 2d 527 (1958—C.A. 2) 15

Authorities

Walker on Patents, Deller's Edition, Section 85, Page 355 19

Statute

Title 35, United States Code Secs. 102 and 103.... 12, 15

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 541

SPARTON CORPORATION,
Petitioner,
vs.
EVANS PRODUCTS COMPANY,
Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

STATEMENT OF THE CASE

This petition seeks review of concurrent decisions of the Courts below that two United States patents, Chapman et al., No. 2,834,304 dated May 13, 1958, and Tobin patent No. 2,873,695 dated February 17, 1959 (Ex's 91 and 103, App. to Pet. pages 26a, 46a) granted to Respondent, are valid.

Infringement of both patents is and was conceded at trial (App. to Pet. page 2a).

Petitioner, Sparton Corporation, initiated this litigation by bringing suit in the United States District Court for the Eastern District of Michigan, Southern Division, for Declaratory Judgment under United States Code, Title 28, Sections 2201 and 2202, against Respondent, Evans Products Company, seeking declaration by judgment that the above two patents and a third patent, to Nampa, No. 2,679,214 (not included in the petition) are invalid and not infringed by Petitioner. (Joint App., pages 6a, 45a). Respondent counter-claimed to enjoin infringement of all three patents and to recover damages for infringement thereof (Joint App. pages 22a, 59a). A fourth patent, Re. No. 14,118 originally in the case, was dropped prior to trial.

The District Court held that all three patents are valid; that the Nampa patent No. 2,679,214 has not been infringed; and that as Petitioner conceded, it has infringed the claims in suit of the Chapman et al. patent No. 2,834,304 and of the Tobin patent No. 2,873,695. In its decision dated August 30, 1961, Appendix to Petition, pages 1a-18a, the Court of Appeals for the Sixth Circuit affirmed "in all respects" the judgment of the District Court.

In the Courts below, petitioner contended that the Chapman et al. and Tobin patents and claims in suit are invalid on the ground that, in view of prior patents and instances of alleged prior public use, (some of which relate to devices for securing separate and usually heavy articles of freight in railway boxcars to which the patents in suit relate, and others of which have to do with burglar-proof locks, domestic bedsteads and undertakers' hearses, which have no relation to the environment and subject matter of the patents in suit), these claims are for obvious and unpatentable ag-

gregations and fail to meet the conditions for patentability prescribed in Section 103 of Title 35, U. S. Code, (App. this brief) and in view of earlier decisions of this Court. Petitioner's First and Second Questions relate to these contentions.

Petitioner also contended below that the Chapman et al. patent and claims in suit are invalid on the ground that the invention covered thereby was "on sale" in this country more than one year prior to the date of the application for the Chapman et al. patent, contrary to paragraph (b) of Section 102, of Title 35, U. S. Code, (App. this brief). In its Third Question, petitioner renews this attack.

ARGUMENT

THE DECISIONS BELOW ARE CLEARLY CORRECT

Petitioner's contentions with respect to validity of the Chapman et al. and Tobin patents were carefully considered and rejected by both Courts below. Both Courts were satisfied, based upon full consideration of the substantial evidence, that these patents are for new and useful structures having new modes of operation which would not have been obvious to persons of ordinary skill in the art. (District Court Findings 8 and 12; Joint App. pages 76a-80a, 86a-88a; Court of Appeals Decision, App. to Petition, pages 3a, 9a-11a, 15a). Moreover, the petition raises no question of conflict with other Courts of Appeal or with this Court and it raises no unsettled question requiring review by this Court.

Instead, this is plainly and simply a patent controversy of a familiar pattern in which Petitioner, though freely conceding infringement, sought to justify its appropriation of Respondent's developments by denying validity, and, having been defeated in both Courts below, now seeks a

third hearing in this Court on questions carefully considered and decided by the Courts below. Such a case does not warrant review by this Court (*Magnum Import Company v. Coty*, 262 U. S. 159; 67 L. Ed. 922). The Petition should therefore be denied.

Chapman et al. and Tobin Patents

Respondent has been engaged for a number of years in the development and manufacture and sale of permanent, reusable dunnage equipment for use in railroad freight cars, cargo ships, trucks and elsewhere to hold freight in place therein. The Chapman et al. and Dunlap patents are for inventions developed by Respondent in the course of this work.

Such equipment is widely used today, particularly in railroad freight cars, to secure unwieldy articles of freight, to speed up and simplify loading and unloading operations, and to eliminate costly freight damage claims which have long been a source of vexation to railroads and shippers alike and which result from the very severe shocks to which the freight is subjected and by which it was formerly damaged when the cars are "bumped" or "impacted" while in transit and particularly in yard operations. Equipment of this sort is subjected to very high loading and to severe shocks and receives very rough handling. To meet these service requirements the equipment is necessarily complex and rugged. The patent literature is replete with proposed loading equipments, but only a few have displayed enough merit to reach the market.

Chapman et al. Patent No. 2,834,304

The Chapman et al. patent (Ex. 91, App. to Pet. pages 26a-45a) shows equipment developed in fulfilling two research and development contracts with the United States

Navy, to hold cargo in place in ships, but useable as well in freight cars (Col. 1, Line 16 of the patent, Joint App. 550a-55a, 560a, 581a-82a, 594a-98a). Very briefly, it provides a highly flexible and adjustable arrangement which enables containment and stowage of a wide variety of types of cargo and comprises freight engaging cross-bars which span and are supported at their ends upon aperatured supporting surfaces or belts. The supporting surfaces or belts have three identical rows of identical holes extending throughout their length and the cross-bars, which are telescopic to enable changes in length thereof, have fittings at their ends provided with load bearing and latching pins which enter and engage in holes of uniform size and spacing in the belts to secure the bars in place in desired locations relative to the freight and with any selected one of the four faces of the bars presented to the freight. The faces of the bars also have pin-receiving holes so that they can receive latching and load-bearing pins carried at the ends of, and thereby support, other "tomming" bars in freight engaging position.

The claims in suit describe the Chapman et al. structure with great particularity. Briefly, claims 5 and 6 define combinations comprising spaced supporting surfaces or belts on opposite surfaces of a freight receiving space, each belt having three identical rows of identical holes extending therealong, and further comprising telescopic bars extending between the belts and connectible thereto, the bars having pairs of load bearing and latching pins lying midway between and protected by the load bearing pins, the load bearing and latching pins being dimensioned and positioned relative to each other so that they are insertable in any set of three holes in any one of the rows or in corresponding holes in all three rows, so that the bars can be located anywhere along any single row of holes or turned in 90° incre-

ments, so that the load bearing pins enter corresponding holes in the outer rows and the latching pins enter holes in the center row, thus making it possible to present any selected one of the four bar faces to the load. Claims, Nos. 1 and 3, in suit are directed to the tomming bars in detail.

Tobin Patent No. 2,873,695

The Tobin patent (Appendix to Petition, pages 46a-58a) is directed to a freight holding system which provides what is known as "pitch-splitting" and makes possible fine adjustments of the position of car-spanning cross-bars to take up the gaps between the faces of the bars and the freight engaged thereby.

The Tobin cross-bars have pairs of pins at their ends engaged in holes arranged in equidistantly spaced vertical and horizontal rows, in the vertical surfaces of wall supports or plates. The bars can be attached to the wall supports in any one of four axially rotative positions, each spaced 90° apart, and thus each bar face can be caused to face or be presented in any one of four directions.

The pins on the bars are aligned with each other endwise of the bar, but have a dual eccentricity relative to the longitudinal axis of the bar. By virtue of this dual eccentricity, if a bar is shifted from one axially rotative position to another, the positions of the four faces, fore and aft, and up and down in the car, also shift, enabling the workman handling the bar to select the rotative position which most snugly closes the gap between the freight being contained and the face of the bar presented to that freight.

Claims, Nos. 4 and 5, in suit are directed in detail to the combination of the bars having the pairs of eccentrically located pins and the wall supporting surfaces therefor with the holes equidistantly spaced horizontally and vertically so as to provide the four-rotative pitch-spliting positions.

Claims, Nos. 1, 2 and 7, in suit are directed to the cross-bars and specify the dual eccentricity of the pins with respect to the bar axis. Claim 1 additionally specifies that the bar body contains a Z-shaped reinforcing element, enabling by rotation of the bar, a choice of two different "beam" strengths, one such choice providing greatest strength in restraining up and down movement of the freight and the other providing greatest strength in restraining forces acting fore-and-aft in the car.

Prior Patents and Instances of Alleged Prior Public Use Relied Upon by Petitioner

Petitioner makes no pretense that any of the numerous prior patents and instances alleged of public use relied upon by it, and rejected by the Courts below, have the structure, or mode of operation, or achieve the results of the Chapman et al. structure of the claims in suit. It does not challenge the specific findings of the District Court, (Finding 8, Joint App. 76a-80a) as to the structure and mode of operation and results attained by these prior patents and alleged instances of prior public use. Of these prior patents and alleged instances of public use Petitioner refers in its petition only to the so-called CH4B bar, (Joint App. 620a), the Milwaukee bar, (Joint App. 619a) and the bar of the Tobin patent in suit (App. to Pet. 46a), the wall structures with which these bars were used or disclosed, and the Diskin patent No. 1,585,089 (App. to Pet. page 62a) which is for a Burglar-proof Lock and has no relation whatsoever to the freight loading field. None of these structures disclose or suggest the combination of the three-row belt arrangement and load-bearing pin and protected intermediate latching-pin-arrangement of the Chapman *et al.* patent, which as aforesaid enables the cross-bars to be located anywhere in any one of the three rows of holes in the belts or turned with the pins entering and engaged in the corresponding holes in the three rows of holes so that any selected face can be presented to the freight.

Petitioner takes a like position respecting the Tobin claims in suit, and does not challenge the findings of the District Court (Finding 12, Joint App. 86a-87a) respecting the structure, mode of operation and results attained with the patents and alleged instances of public use relied upon by Petitioner. In its petition, Petitioner cites only the Van Deest patent, (App. to Pet. page 59a) which is for a bier pin for use in hearses, and has nothing to do with freight loading. As found by the Courts below, it fails to disclose or suggest the structure and mode of operation of the Tobin patent.

The Court below fully considered the Chapman *et al.* and Tobin structures, and the prior patents and instances of alleged prior public use urged against them, and, affirming the District Court, concluded: (App. to Pet. page 9a)—

> "—that those patents urged by Appellant as having made the Nampa, Chapman-Dunlap and Tobin patents obvious to one of ordinary skill in the art, thereby rendering the three patents in suit invalid, clearly do not accomplish that result."

In its consideration of the validity of the Chapman *et al.* and Tobin claims, the Court below said (App. to Pet. pages 10a-11a):

> "Patentablility of combinations of old elements may be found when the elements co-act to produce a new result by a new method of operation. As we said in *Cold Metal Process Co. v. Republic Steel Corporation*, 233 F. (2d) 828, at page 936: 'The controlling question is whether this combination has a new method of operation, and whether the new and useful results were obtained in a manner which was or was not obvious to persons of ordinary skill in the art. *American Chain & Cable Co., Inc. v. Rochester Ropes, Inc.*, 4 Cir., 199 F. (2d) 325.'

"In the Nampa* patent is found, for the first time in the freight-bracing art, the feature of telescopic heads that co-act with the bars and wall members to produce a freight-bracing device to alleviate the dropping of the goods in transit. This constitutes a new method of operation that meets the test set forth in the *Cold Metal Process* case, *supra*.

"In the Tobin patent, we find the pitch-splitting feature. This also achieves a new result in the freight-loading field. By combining this new feature with the known elements of the art, a new result was achieved—that is, a new and easy method of snubbing up the freight which, before, had not been possible to such degree without the use of extra wedges, etc.

"One of the problems in designing a freight dunnage system, to be installed permanently in the freight car, is the provsion for flexibility and versatility in positioning of the freight-holding bars. Any given freight car will carry vastly different loads from time to time, each requiring a different placement of the bars adequately to secure the goods in transit. Although the Nampa and the Tobin systems permitted some adjustment in the general placing of the bars, the Chapman-Dunlap system goes farther; and, by arrangement of the three-hole wall-member system, provides great flexibility in the possible location of the bar. The three equally spaced holes in each wall member, combined with the two-load bearing pins and the latch pin on the bar head, enable the bar to be placed in a variety of positions and heights. The co-action of the three-hole wall-member system with the other elements of the system results in a new effect not before achieved in this field, thereby meeting the test of the *Cold Metal Process case*."

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*Not involved in the Petition for Writ of Certiorari.

The decision in the Cold Metal case, to which the Court of Appeals refers and which it follows in the instant case, applies tests which are in agreement with those considered sound and in accord with law by this Court in the cases relied upon by petitioner, namely, *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950), 95 L. Ed. 162, and *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corporation*, 303 U. S. 545 (1937), 82 L. Ed. 1008. It is submitted that the record in the case at bar fully justifies the decisions below, holding valid the Chapman *et al.* and Tobin claims in suit.

The "On Sale" Defense with Respect to the Chapman et al. Claims in Suit

With respect to this defense, to which petitioner has directed its Third Question, the record shows that in January 1952, Respondent, then engaged in filling an order placed by Union Pacific Railroad for loading equipment suggested that if Union Pacific were agreeable Respondent would, without cost to Union Pacific, develop and install, for trial and experimental purposes a sample set of removable door posts in one of a series of double door cars then on order from Union Pacific. All concerned anticipated a need for such posts to meet a prospective shipping schedule of Ford Motor Company. This proposal was accepted, Respondent proceeded with the development and manufacture of the posts, and on March 18, 1952, Union Pacific Car No. 505,071, equipped with the posts, was turned over to the Detroit, Toledo & Ironton Railroad to be tried in regular Ford service, it being here noted that use in actual railway service is the best and frequently the only way to adequately test heavy duty railway equipment such as is here involved. (Entire paragraph, 348a, 537a-41a, 570a, 574a-75a.)

In June 1952 Respondent furnished the Detroit, Toledo and Ironton Railroad two quotations (Ex's 210, 211, Joint App. 689a-92a, Appendix to Petition, pages 68a, 69a) both of which, at the Railroad's request, listed "removable door-posts" as a part of the equipment, but did not specify any details as to the structure of these posts. In August 1952, the Detroit, Toledo and Ironton Railroad issued its purchase order (Ex. 212, Joint App. 693a, App. to Pet. page 70a) to Respondent covering equipment for 300 cars according to one of the quotations, but cancelled the purchase order before Respondent assembled any material or started any production to fill the order. The record is clear and the District Court found (Finding 10, Joint App. 85a) that the door posts in Car No. 505,071 were trial and experimental posts and were still, to the knowledge of all concerned, in the experimental stage at the time the quotations and purchase order were made and issued. (Entire paragraph Joint App. 542a-46a, 548a-50a, 558a, 562a-65a, 577a-78a.)

The Courts below correctly held, under the authorities discussed under the heading "Petitioner's Third Question", that the provisional and abortive quotations and cancelled purchase order noted above, occurring while the door posts were in an experimental stage, did not constitute either a "sale" or a placing "on sale" of any inventions embodied in those door posts.

Moreover, Petitioner makes no pretense that the removable door posts in car 505,071 meet the Chapman *et al.* claims in suit. These vertically used posts had at their lower ends pins like those of the Chapman et al. patent in suit, but at the upper end of each post only a single pin was provided that projected into a single hole in the overhead structure of the car door; the door sill carried a plate having a single series of three holes but not three rows of holes

to receive the pins on the lower end of the post; and these posts contained no provision whatever for telescoping or otherwise adjusting the length of the posts. (Joint App. 329a-30a, 341a, 367a-69a, 579a-80a, 586a-87a, and Ex's 2 and 77B-77E, Joint App. 607a, 644a-47a.)

Thus, these posts could not be used as a substitute for the bars of Claims 1 and 3, or in the three row belt and triple-pin-bar combination of Claims 5 and 6. Consequently Petitioner's "on sale" defense, even if established would not impair the validity of the Chapman et al. claims.

THIS CASE PRESENTS NO QUESTION REQUIRING REVIEW BY THIS COURT

First Question

Through its First Question, Petitioner seeks a ruling that since enactment of Section 103 of Title 35 United States Code a holding of validity requires not only a finding (1) that, under Section 103, the subject matter patented would not have been obvious to a person of ordinary skill in the art, but also a finding (2) that it is for a patentable combination and not an aggregation.

Petitioner's First Question is entirely moot in this case, since the Court below has made both such findings.

More particularly, as pointed out at page 3 of this brief, the Courts below have found upon the substantial evidence presented that the subject matter claimed in the Chapman *et al.* and Tobin patents produced new and useful structures and modes of operation which would not have been obvious to persons of ordinary skill in the art, thus complying with Section 103 of Title 35, United States Code. The Court of Appeals below also found that Petitioner's contention that the correct standard of invention had not been applied and that the claims were for aggregations and not patentable combinations were without merit (App. to Peti-

tion 3a), and that by the combinations of elements the Tobin and Chapman-Dunlap patents achieved new results not before attained in this field (App. to Petition, page 11a) and as to each, found patentable invention present (App. to Petition, page 15a). These findings were made with reference to the standards followed in *Cold Metal Process Co. v. Republic Steel Corporation*, 233 F. (2d) 828, (C.A. 6 1956), in which the Court considered the Great Atlantic & Pacific and Lincoln Engineering cases, *supra*, both of which were relied upon by Petitioner here in the Court below (and in which as here claims to a structural combination were under attack as aggregations of old elements). At pages 836, 838 and 839, in the Cold Metal case, the Court stated:

> "The controlling question is whether this combination has a new method of operation, and whether the new and useful results were obtained in a manner which was or was not obvious to persons of ordinary skill in the art. *American Chain & Cable Co., Inc., v. Rochester Ropes, Inc.*, 4 Cir., 199 F. 2d 325.
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> * * * * *
>
> "In order to secure a true and patentable combinaiton of old elements, the elements must co-act to produce the result achieved, the result must be new and useful, and the method of operation must be new. *Great Lakes Equipment Co. v. Fluid Systems, Inc.*, 6 Cir., 217 F. 2d. 613, 617. If the method of operation is new and the result is new the old elements perform a new function in their new environment."

Manifestly, the tests employed in the Cold Metal case which the Court followed and applied in the case here at bar are in agreement with those considered sound and in accord with law by this Court in the Great Atlantic and Pacific Tea Co. and Lincoln Engineering cases. Consequently, the findings in the present case, constitute in all re-

spects the findings urged by Petitioner as necessary to support a finding of validity.

Moreover, Petitioner has wholly failed to demonstrate the existence of any conflict of decision touching Petitioner's First Question or of any unsettled significant question requiring resolution by this Court. Lack of such conflict or unsettled question is virtually admitted at page 10 of the Petition in which it is noted that in over 400 cases in which the Great Atlantic and Pacific case, has been cited—

> "—this Court's test for the standard of invention of combination patents has been, with few exceptions, consistently applied in finding patents valid as well as invalid."

Of the cases cited by Petitioner with respect to the matter of conflict, *Interstate Rubber Products Corparation, et al. v. Radiator Specialty Company, et al.*, 214 F. 2d 546 (C.A. 4, 1954) and *John Blue Company, Incorporated v. Dempster Mill Mfg. Co.*, 275 F. (2d) 668 (C.A. 8, 1960) are in complete accord, as is manifest from the extracts quoted in Petitioner's brief.

The case of *Blish, Mize and Silliman Hardware Company et al. v. Time Saver Tools, Inc., et al.*, 236 F. 2d 913 (1956, C.A. 10) cited by Petitioner shows no conflict between the Tenth Circuit and other Circuits. Any uncertainty expressed by the Court in the Blish case is *obiter dicta*, since it held the patent there involved invalid under Section 103 of Title 35 United States Code as being based upon a structural change that "should have been obvious to the ordinary mechanic." And, moreover, the decision in *Jamco, Incorporated v. Carlson*, 274 F. (2d) 338 (1959—C.A. 10) is in complete accord with the Interstate and John Blue cases, *supra*, discussed above. In the Janco case, the Court held valid a patent on steering gear arm assemblies as meeting

the standards of both Section 103 of Title 35, United States Code and the Great Atlantic & Pacific case, *supra*.

The remaining case cited by Petitioner, *Zooman, Inc. v. Paillard Products, Inc.*, 258 F. (2d) 527 (1958—C.A. 2) shows no conflict between the Second Circuit and other Circuits. In it the Court held the patent there involved failed to meet the tests of either Section 103 or the Great Atlantic & Pacific case.

Second Question

Petitioner's Second Question seeks a reversal by this Court of the judgment of the Court of Appeals in this case on the ground that the Court of Appeals erred in affirming the judgment of the District Court because it was based upon Findings of Fact and Conclusions of Law which did not include a Finding of the specific nature referred to in Petitioner's First Question and it seeks a ruling that such a finding by the District Court is essential to holding a patent valid.

As pointed out in the consideration of the First Question, the present record shows that the Court of Appeals made findings which are clearly adequate under this Court's decision in the Great Atlantic & Pacific Tea case, *supra*, to support the affirmance, by the Court of Appeals of the judgment of the District Court. The issue presented to the Court of Appeals was the correctness of the judgment of the District Court. The fact that that judgment may have been rendered without a finding that the Tobin and Chapman-Dunlap patents were for patenable combinations, as distinguished from unpatentable aggregations, did not require reversal by the Court of Appeals, as suggested by the Petitioner's Second Question. Neither did it estop Respondent from urging before the Court of Appeals that the record supported such a finding or estop that Court from making such a finding.

The rule is universally recognized both in this Court and in the Courts of Appeal that a respondent or appellee may urge, in support of a judgment, and an upper court in affirming the judgment below, may rely upon, any ground supported in the record. This doctrine was clearly stated in this Court's opinion written by Mr. Justice Brandeis in *United States v. American Railway Express Company*, 265 U. S. 425, 435, 68 L. Ed. 1087, 1093:

> "But it is likewise well settled that the appellee may, without taking a cross appeal, urge in support of a decree, any matter appearing in the record although his argument may involve an attack upon the reasoning of the lower court or an insistence upon matter overlooked or ignored by it. By the claims now in question the American does not attack, in any respect, the decree entered below. It merely asserts additional grounds why the decree should be affirmed."

This rule has been repeatedly stated and applied by this Court and this case cited in support thereof. See *Langnes v. Green*, 282 U. S. 531, 538, 75 L. Ed. 520, 525; *Story Parchment Co. v. Patterson Parchment Paper Co.*, 282 U. S. 555, 560, 75 L. Ed. 544, 547; *Morley Construction Co. v. Maryland Casualty Co.*, 300 U. S. 185, 191, 81 L. Ed. 593, 597; *United States v. Carignan*, 342 U. S. 36, 38, 96 L. Ed. 48, 51; *Jaffke v. Dunham*, 352 U. S. 280, 281, 1 L. Ed. 2d 314, 315. In the last case this Court succinctly stated in a *Per Curiam* opinion, at 352 U. S. page 281,

> "A successful party in the District Court may sustain its judgment on any ground that finds support in the record."

This rule is equally applicable in patent cases. See *Katz v. Horni Signal Mfg. Corp.*, 145 F. 2d 961, 962 (C. A. 2), *Tinnerman Products, Inc. v. George K. Garrett Co., Inc.*,

292 F. 2d 137, 138, (C.A. 3), *Guiberson Corp. v. Equipment Engineers*, 252 F. 2d 431, 432 (C.A. 5); *Baric v. Superior Tanning Co.*, 182 F. 2d 724, 728 (C.A. 7); *L. McBrine Co. Ltd. v. Silverman*, 121 F. 2d 181, 182 (C.A. 9), *Moore v. C. R. Anthony Co.*, 198 F. 2d 607, 663 (C.A. 10). Thus, the Court of Appeals in this case clearly did not err in affirming the judgment of the District Court and amplifying the grounds supporting the judgment.

Also, the Petitioner's second question seeks to have this Court pass on a matter as to which there is no conflict in the decisions of the courts. In the present case, as stated, the Court of Appeals found that the inventions of the Tobin and Chapman-Dunlap patents in addition to being far from obvious to one skilled in the art, are for patentable combinations, as distinguished from aggregations, and that the elements of these combinations co-act to achieve new results not before attained in this field. The decision of the Court of Appeals in *Kwikset Locks v. Hillgren*, 210 F. 2d 483 (C.A. 9) cited by Petitioner was based, not upon the belief that it would have been error for it to make such a finding, had the record there supported it, but upon the fact that in that case it found no basis in the record for such a finding. The Court in that case, upon comparing the patented combination with the prior art, stated, page 487:

> "Such differences as there is to be recognized must be retricted to the realm of admittedly skillful mechanical know-how."

Similar are *Crane Packing Company v. Spitfire Tool & Machine Co., Inc.*, 276 F. 2d 271 (C.A. 7), *Bode et al. v. Baker & English*, 274 F. 2d 833 (C.A. 6), and *General Motors Corp. v. The Estate Stove Company*, 201 F. 2d 645 (C.A. 6). The decisions there were based upon findings that the subject matter claimed was obvious to persons

having ordinary skill in the art. These cases have no application to the case at bar, in which both courts below after full consideration of the prior art and evidence presented found that the subject matter claimed in the patents here in suit produced new and useful structures and modes of operation which would not have been obvious to persons having ordinary skill in the art.

And, contrary to the assertion at page 19 of the Petition, in the Cold Metal Process case, in stating the tests quoted therefrom in this brief, the Court, as here, was dealing with apparatus claims under attack as being aggregations of old elements.

It is plain that Petitioner's Second Question affords no warrant for review of this case by this Court.

Third Question

Petitioner's Third Question does not present an issue warranting the issuance of a writ of certiorari. The question as stated by Petitioner is not presented by the facts of the present record. The present record does not show any "unequivocal offer to sell railroad freight bracing equipment corresponding to that being demonstrated in revenue service in a freight car." The letters, Defendant's Exhibits 210 and 211, (Joint App. 689a, 691a, App. to Pet. 68a) do not specify in any way the construction of the removable door posts which were proposed to be included in the equipment quoted upon in those letters. It was known by all concerned that the removable door post was still in the experimental stage, that it had not been perfected, and that changes might be made in the development of it and that the construction then in experimental use might or might not be used in producing the posts needed to fill the order. (Wilbur Joint App. 563a-564a, Webb Joint App.

548a-549a.) That the two removable door posts in use at the time of the letter of quotation were still in the experimental stage was specifically found by the trial court in Finding No. 10 (Joint App. 82a-85a) which the Court of Appeals held to be amply supported by substantial evidence. These facts fall short of showing an unequivocal offer to sell equipment of any specific construction.

Secondly, the Third Question is one as to which there is no conflict in the decisions of the Courts, on the facts of the present record. Nor does the Third Question raise on the present record, any unsettled question of law. Where as has been found by both courts below, the equipment in question was in the experimental stage throughout the period in question, all courts agree that it cannot, while in such experimental stage, be "in public use or on sale" within the meaning of that language of Section 102 (b) of the Patent Act of 1952. This is well established by *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. Ed. 1000; *McCreery Engineering Co. v. Massachusetts Fan Co.*, 195 F. 498 (C.A. 1); *Burke Electric Co. v. Independent Pneumatic Tool Co.*, 232 F. 145 (C.A. 2); *Walker on Patents*, Deller's Edition, Section 85, page 355. None of the cases cited by Petitioner hold to the contrary and in fact, in *Wende v. Horine*, 225 F. 501 (C.A. 7) it is expressly recognized that the offer to sell must be "after the experimental stage has been passed". The remaining cases relied upon by Petitioner are all distinguishable upon their facts in that in none of them was the equipment held to be in the experimental stage nor, in fact, was there even any issue or claim of experimental use.

A third reason for rejecting the Petitioner's third question as a basis for the granting of this petition is that on the record in this case it presents a wholly moot issue because as pointed out above, none of the adjudicated claims of the Chapman-Dunlap patent, the only patent against

which the "on sale" defense is asserted, read upon the structure to which the Petitioner relates the offer to sell. This is apparent from a comparison of Claims 1, 3, 5 and 6 of this patent with the structure of the removable door posts of Union Pacific Car No. 505071 as set out in the trial court's Finding of Fact No. 10 (Joint App. 82a-85a).

CONCLUSION

For the foregoing reasons it is respetfully submitted that this petition for writ of certiorari should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that copies of the foregoing Brief for Respondent in Opposition were duly served upon Petitioner herein, by depositing same in the United States mail, first class postage prepaid, addressed to Townsend F. Beaman, 501 Reynolds Building, Jackson, Michigan, Attorney for Petitioner, on December 29, 1961.

Cyrus G. Minkler,
Attorney for Respondent.

APPENDIX

STATUTE INVOLVED

Patent Act of July 19, 1952, Title 35, United States Code.

"§102. Conditions for patentability: novelty and loss of right to patent.

"A person shall be entitled to a patent unless—

* * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *"

"§103. Conditions for patentability; nonobvious subject matter.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."